



DOCKET NO: 216597US2PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
ADRIANO HUBER, ET AL. : EXAMINER: BAYAT, B. B.
SERIAL NO: 09/926,686 :
FILED: DECEMBER 3, 2001 : GROUP ART UNIT: 3621
FOR: METHOD FOR SELLING AND :
USING MEDIA OBJECTS AND A
DEVICE SUITABLE THEREFOR

REPLY BRIEF UNDER 37 CFR § 41.41

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a Reply Brief in response to the Examiner's Answer (hereinafter "EA") mailed April 27, 2007. This Reply brief is presented in order to point out and respond to numerous errors in the EA as to clearly improper and unreasonable interpretations of the limitations of the appealed claims and the teachings of the references relied on in the rejection made under 35 U.S.C. § 103(a), the only rejections at issue in this appeal.

LIMITATIONS NOT TAUGHT BY EITHER REFERENCE

Pages 3-6 of the EA are a repeat of the rejection and rationales offered at pages 3-6 of the outstanding final Action without the previously recited attempt to incorporate unspecified teachings from the references that was set forth in the paragraph bridging pages 6 and 7 of the outstanding final Action. This statement of reliance on other parts of the references that are not identified or analyzed as to the limitations of the rejected claims was the basis for noting that the consideration of the rejections is limited to the parts of Downs and Zhoa that have

been relied on as Applicants have been given no opportunity to comment on such other teachings as set forth in note 1 on page 4 of the Appeal Brief with reliance on *In re Arkley*, 455 F.2d 586, 589, 172 USPQ 524, 527 (CCPA 1972). As the EA sets forth no locations as to any new teachings of Downs and Zhoa that are relied upon, the first question to be answered by this appeal relates to the adequacy of the analysis offered as to the claim limitations and the teachings of Downs and Zhoa set forth at pages 3-6 of the EA in terms of meeting each and every limitation of Claims 1-22 to establish a *prima facie* case.

In this regard, and as noted in the paragraph bridging pages 4 and 5 of the Appeal brief, the repeated rationale expressly offered as to rejecting Claim 1 (and offered by implication as to Claim 13) is that Downs teaches the limitation of Claim 1 step requiring “transmitting an object order for digital media objects that comprises at least one object identification by a mobile communications terminal over a mobile radio network to a center” because it teaches “transmitting an object order for digital media objects that comprises at least one object identification (figure 1b, 1d, 2 and associated text).”

First of all, the reference to three different figures and a general reference to associated text clearly violates 37CFR § 104 (c)(2) that states “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable” (emphasis added). Also note *In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (“When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”).

Second, the limitation as asserted in the final Action and in the EA is incomplete. The actual step of Claim 1 is noted above and it clearly requires more than simply “transmitting an object order for digital media objects that comprises at least one object identification,” because it further requires this transmission to be “by a mobile communications terminal

over a mobile radio network to a center” (emphasis added). However, the EA and the final Action simply ignore the requirement for a “mobile communications terminal” to do the transmission over a “mobile radio network to a center” and do not designate anything at all as corresponding to these three recited elements from the teachings of Downs.

This lack of explanation as to this requirement for a “mobile communications terminal” to do the transmission over a “mobile radio network to a center” was pointed out in the Appeal Brief, but the only response in the EA is a conclusion that is not understood in terms of an assertion at page 7 of the EA that “[t]ransmission by a mobile communications terminal over a mobile radio network to a center is common to the cited references and therefore generic to the claims.” As was pointed out in the Appeal Brief as to the *Warner*, *Zurko*, and *Lee*, decisions and discussion at the bottom of page 6 to the end of the first paragraph on page 8, more than such unsupported conclusions are required. This was recently reinforced by the PTO reviewing Court in *In re Kahn*, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) as follows:

[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *Lee*, 277 F.3d at 1343-46; *Rouffett*, 149 F.3d at 1355-59. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in §103. See *id.* at 1344-45.

The clearly improper conclusion is followed by a further unsupported generalization asserting that Downs somehow “discloses utilizing the invention” (which one?) via any communication network via telephone or cable connection.” Missing from this assertion is the above-noted 37 CFR § 104 (c)(2) requirement that “the particular part relied on must be designated as nearly as practicable” (emphasis added) and the similar requirement of the above-noted Rijckaert decision requiring that “[w]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”

Also, while it appears that Downs is concerned with delivery and rights management over global communications networks, like the Internet or World Wide Web, see col. 1, lines 51-56, this cannot be said to be a teaching of communication “via any communication network via telephone or cable connection” as asserted. Also, these generalizations fail to point out what is taught by Downs that is being interpreted to be the required “mobile communications terminal” (emphasis added), the “mobile radio network,” or the “center” (emphasis added).

The EA follows this improper conclusion as to the teachings of Downs with similar improper conclusion as to the teachings of Zhao. In this regard, while page 13 (in the introduction “1”) of Zhao mentions cheaper end-user devices (e.g. PCs, Tv set-top boxes, and wireless hand-held devices,) no mention is made of the required “mobile communications terminal” (emphasis added), the “mobile radio network” (emphasis added), or the “center.” Also, the EA is silent as to how these claim elements are taught by the noted Zhao cheaper end-user devices, much less the manner that these Zhao cheaper end-user device teaching would be used to modify unnamed elements of Downs.

In this last regard, the final Action and the EA both appear to rely only on Downs to teach the first step of Claim 1, not that the above-noted Zhao cheaper end-user device teachings are being relied upon to teach part of this first step. Also missing is any hint of which of these cheaper end-user devices are being asserted to be used to modify Downs to realize the claim requirement for the transmission by the “mobile communications terminal” (emphasis added), over the required “mobile radio network” (emphasis added), and to the “center.”

It is by now well established that the PTO has the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ

459 (1966), made clear that under § 103, the scope and content of the prior art are to be determined and differences between the prior art and the claims at issue are to be ascertained in every instance. Thus, the approach adopted in the final Action and the EA of attempting to brush such differences under the carpet violates the dictates of *Graham* as well.

Moreover, this requirement of *Graham* to properly ascertain the differences between the prior art and the claims at issue is a prerequisite to formulating any rejection under 35 U.S.C. § 103. Note that the PTO reviewing court also emphasized that conclusory findings that omit analysis as to all claim limitations are improper in *Gechter v. Davidson* 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) (cited on page 6 of the Appeal brief.) These prerequisites to making any valid rejection under 35 U.S.C. § 103(a) are not erased because they are not immediately traversed as being deficiencies of a rejection being asserted by the PTO as apparently urged at the bottom of page 7 of the EA. Thus, any rejection under 35 U.S.C. § 103(a) that fails to follow the above-noted dictates of *Graham* (as to correctly ascertaining the differences between the prior art and the claims at issue) and *Gechter* (as to properly construing the claim terms before finding that the reference discloses just such terms) is deficient when made and that deficiency is not erased because it is not immediately pointed out.

As noted at page 6 of the Appeal Brief and emphasized here:

Contrary to *Gechter*, the Claim 1 and Claim 13 requirements for “a mobile communications terminal,” a mobile radio network” and “a center” are not in anyway analyzed and no findings are made as to what disclosed elements in Downs and/or Zhao reasonably correlate thereto. Similarly, there is no attempt in the outstanding final Action to properly consider the requirements of the Claim 1 step of “transmitting a media object assigned to the object identification by the center via a radio network to the communications terminal, where the media object is stored in a memory” (and corresponding Claim 13 structure) in terms of identifying anything in the references that reasonably teaches “the center” or the required transmission of “object identification” by this center “via a radio network to the communications terminal.”

As further noted at pages 8 to 9 of the Appeal Brief and not responded to in the EA:

With further regard to relied on general teachings associated with figure 1b, 1d, 2, and associated text, the particular parts therein that are being relied on to teach the above-noted claim requirements as to the first transmitting step of Claim 1 and corresponding structure of Claim 13 are never specified. Such general incorporation of large scale disclosures encompassing many elements and many different options as to operation is not seen to comply with the 37 CFR § 1.04(c)(2) requirement that all claim rejections “for want of novelty or for obviousness” are to designate “the particular part relied on” whenever “a reference is complex or shows or describes inventions other than that claimed by the applicant,” as is the case with Downs. Further note *Lee*, at 277 F.3d 1338, 1342, and at 61 USPQ2d 1430, 1432-33, and the requirement there that the PTO must “... present a full and reasoned explanation of its decision.”

The final Action contains similar violations of precedent as to the position therein that some hidden disclosure in column 6, line 35-column 8, line 54; column 40, lines 53-67; column 46, lines 10-61 can be said to teach or suggest transmitting data on a time at which an ordered media object is available by the center to any communications terminal, wherein the time is determined by the center and is stored in the communication terminal.” Once again the final Action fails to point to the elements in the hodgepodge referenced that are believed to perform as the claimed “center,” the claimed “communication terminal,” or storage of time in this “communication terminal.”

In this regard, column 6, line 35-column 8, line 54, consists mostly of a system overview of the Downs system that lacks any details relevant to the second step of Claim 1 or corresponding structure in Claim 13. Thus, while the Clearinghouse(s) entity is taught to be used to insure valid (authorized) licensing (column 7, lines 11-16, insuring that a license has not expired using such a Clearinghouse(s) entity has nothing to with the second step of Claim 1 or corresponding structure of Claim 13 that requires the availability time to be determined by the same “center” doing the transmitting to the communications terminals and that this time is then stored at the communication terminal.

While column 40, lines 53-67 and lines 10-61, all relate to logging (or storing) dates, these are dates that are logged at the clearing houses 105 when report requests are made and when results are reported, all as clearly stated at column 45, lines 65-66 considered with column 46, line 5, and column 46, lines 63-67. The final Action fails to present any explanation as to what the logging at clearing house 105 into Audit Logs 150 shown in FIG 1C of such report items has to do with storing a time at something that can be said to be a communications terminal as recited by Claims 1 and 13.

For these reasons alone, reversal of the rejection of Claims 1-22 is respectfully submitted to be in order as to the EA failing to demonstrate how the applied references teach each full limitation of base independent Claims 1 and 13. It is well established that a *prima*

facie case of obviousness requires that all claim limitations be considered and demonstrated to be taught or suggested by the prior art, see MPEP §2143.03.

The arguments as to the further deficiencies of Downs at page 9, line 10 to page 11 line 17 have also been ignored. Instead of addressing such arguments, the EA adopts the approach that since the language of the claims can be read as broadly as the Examiner desires (apparently without any regard to the disclosure or the plain meaning of such terms to the artisan), this means that the same claimed elements can be read on different disclosed elements in Downs in the hopscotch manner set forth at pages 3-6 of the EA.

Accordingly, reversal of the outstanding rejection of Claims 1-22 is respectfully submitted to be in order for this reason as well.

TEACHINGS OF ZHAO MISINTERPRETD

As noted at pages 12 of the Appeal Brief, Zhao describes bandwidth-efficient continuous media streaming (see Zhao in the Title and in the Abstract, for example), where continuous media are streamed from a media server to a set of distributed receivers. See Zhao at page 14, column 2, under section 2 “Continuous Media Streaming and Resource Management,” in addition to col. 2 on page 13, lines 32-35, for example. The media server determines a streaming schedule for delivery of a requested media object by the server to a receiver through a continuous streaming process according to the streaming schedules depicted as to Fig 5, where $t=0$ is always the start time. See Zhao at page 15 paragraphs 2.2 and 2.3.

The EA attempts to take these specific teachings as to continuous media stream scheduling completely out of context and interpret the continuous stream scheduling to be an entirely different time of day scheduling in the paragraph bridging pages 8 and 9, as if the teaching were one of scheduling deliveries to start at 3pm, for example. Nothing in the

“broadest reasonable” reading of claim language permits the PTO to insert its interpretation of reference language to change the meaning of the reference language. *See In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Thus, the PTO cannot interpret the Zhao term “schedule,” that is not disclosed to be a time of day schedule, as being a teaching of using a time of day schedule. Accordingly, and as noted at the top of page 13 of the Appeal Brief, Zhao fails to reasonably teach or suggest transmitting data on a time determined by the center with regards to optimal usage of resources used for a transmission of ordered media objects, much less the claimed requirement for automatically contacting the center by the communications terminal at the determined time that is not taught by either Downs or Zhao.

For these reasons as well as those noted above, reversal of the rejection of Claims 1-22 is respectfully submitted to be in order.

- TEACHINGS OF ZHAO AND DOWNS NOT COMPATIBLE

Also, and as noted at the bottom of page 15 it is clear that Downs is concerned with data pre-packaged by Content Providers 101 into SC(s) as described at column 9, lines 49-51. These SC(s) are to be “downloaded” by the end users (see column 11, lines 40-42, for example) that cannot be equated to data being “streamed” as in the Zhao media server determining a streaming schedule for delivery of a requested media object by the server to a receiver through a continuous streaming process according to the streaming schedules depicted in Fig. 5 of Zhao. Thus, the artisan would have no reason to consider modifying the Downs taught “downloaded” by the end users of pre-packaged (by Content Providers 101) SC(s) with the Zhao streaming teachings as they as it would destroy the basic operating principal of Downs. Any proposed modification that would change the basic operating principle of a reference is not an obvious one. *See In re Ratti*, 270 F.2d 810, 813, 123 USPQ

349, 352 (CCPA 1959). Moreover, reference modifications that would render a reference unsatisfactory for its intended purpose are also not obvious. See In re Gordon, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

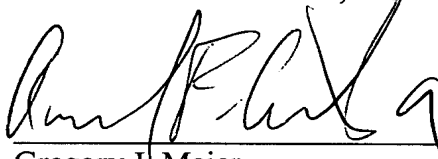
Thus, as there is clearly no reasonable basis that has been established as to modifying the download-play back teachings of Downs by the contrary "streaming" teachings of Zhao, a reversal of the outstanding rejection of Claims 1-22 based on this improper hindsight rationale that ignores the full teachings of Zhao and the incompatibility thereof with Downs is respectfully submitted to also be in order.

CONCLUSION

The rejections applied to Claims 1-22 should all be reversed as being clearly improper under the controlling precedent cited above and for the above-noted reasons as well as those submitted in the Appeal Brief.

Respectfully submitted,

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